

of *Bruno et al.* and in further view of *Nguyen et al.*, and claims 31-33 as obvious under 35 U.S.C. § 103 based on *Bruno et al.* in view of *Gow*.

With respect to the § 102 rejection, the Office Action repeatedly states that the reference of *Gow* discloses “storing data corresponding to a pre-paid telephone calling card and a personal greeting related to said pre-paid telephone calling card,” as positively recited in independent claims 1, 10, 16, and 19. Specifically, the Office Action cites to components 1 and 4 of FIG. 1 (on page 3), and col. 4, lines 10-15 (on page 5) for such a supposed disclosure. Applicants cannot find such a disclosure in the cited passage and drawings, or any where in the reference of *Gow*.

Gow discloses a gift article voice greeting system that includes an access control device 1 and a message recording apparatus 4 (see FIG. 1 and Abstract). The message recording apparatus 4 records voice messages from subscribers to the telecommunications network 3. A message replaying apparatus 7 replays the voice messages to recipients, and an access control device to interface with the telecommunications network 3 and connect a subscriber calling via the telecommunications network 3 to the message recording apparatus 4. The access control device 1 is adapted to connect a recipient calling via the telecommunications network 3 to the message replaying apparatus after the subscriber has given the previously assigned password to replay the message to the recipient. The system also includes a charge allocating system to direct a selected charge in respect of each call to the access control means to the subscriber or the recipient who calls the telecommunications network. The system further includes a printed information block associated with each gift article, which includes information for placing a call to the access control device and a place for recording the assigned password. *Gow* defines a “gift article” (col. 1, lines 12-21) as any physical article which may be given by one person to another, including greeting cards, boxes of chocolates, articles of clothing and any other item

capable of being used as a gift and carrying an associated piece of printed information either by printing on the packaging, the article itself, or by means of an attached tag or label. The gift article may also be any printed medium, such as a card or letter itself, which is capable of displaying the printed information with the recorded message itself constituting the gift.

With respect to the operation of the voice greeting system, in col. 3, lines 10-15, the reference of *Gow* discloses that incoming calls are received by the access control device 1 on the recording telephone number. These calls are directed to a message recording device 4. Per col. 3, lines 49-54, a discrete PIN is assigned to each caller prior to the recording of their message. Provision is made to re-record the message or to listen to the completed message. As instructed by prompts C and D in Table 1, the caller recording the message writes the issued PIN in the boxes 5 provided in the information block of FIG. 2. In the case of plasticised greeting cards, the area within the dotted outline 6 is not plasticised so as to facilitate the writing of the PIN number on the card using a normal writing instrument, such as a ball point pen.

Further, *Gow* discloses, in col. 4, line 56 – col. 5, line 13, that the caller is first informed of the cost of listening to the message. The caller is then required to enter the PIN written in the boxes 5 in the printed information block printed on the greeting card. If the correct PIN is provided the message is replayed to the recipient. In the system of the preferred embodiment the message is retained for a period of one month and during this period the recipient of the card can listen to the message as often as they wish during this 1-month period at a cost of 60c a listen using a 1-900 billing number, provided the correct PIN is entered each time.

Therefore, Applicants contend that *Gow* clearly lacks disclosure of a telephone calling card, much less a pre-paid telephone calling card used in the manner claimed. Applicant's contention is consistent with the fact the Office Action cannot explicitly state how the claimed pre-paid telephone calling card is met, as none of the cited passages discloses a "telephone

calling card.” As best as can be understood, the Office Action appears to equate the gift article in the *Gow* system as the pre-paid telephone calling card. This interpretation, however, cannot be sustained, as *Gow* nowhere describes telephony services as a gift. A general disclosure that a gift article is a “physical article” (e.g., greeting cards, boxes of chocolates, and articles of clothing) clearly falls short of a telephone calling card.

As anticipation under 35 U.S.C. § 102 requires that each and every element of the claim be disclosed in a prior art reference, based on the foregoing, it is clear that *Gow* does not anticipate independent claims 1, 10, 16, and 19, or the corresponding dependent claims 2, 6-9, 14, 15, 17, 18, 20, and 24-26.

With respect to the obviousness rejection of independent claim 27, the Office Action, on page 9, asserts that *Gow* discloses a method for facilitating the user of a pre-paid telephone calling card having an associated pre-recorded personal greeting. As proffered in the arguments for the withdrawal of the § 102 rejection, *Gow* does not disclose a pre-paid telephone calling card.

In addition to the step of “storing data corresponding to a pre-paid telephone calling card and a personal greeting related to said pre-paid telephone calling card,” independent claim 27 recites “receiving a request to make an outbound telephone call in relation to said pre-paid telephone calling card.” The Office Action (on page 9) acknowledges that the *Gow* reference fails to disclose an outbound telephone call. To cure this deficiency, the Office Action relies on *Bruno et al.* for such a supposed teaching.

Bruno discloses a system for accumulating charges for telecommunications services used during a calling card call (see Abstract). In particular, the system for records charges for services used by a calling card user in real time so that charges for actual services used by the cardholder accrue against the calling card account (col. 1, lines 31-34).

Furthermore, by its own admission, the Office Action on page 13, item 7 states that *Bruno et al.* “fails to disclose personal greeting associated with said pre-paid telephone calling card.”

The combination of *Gow* and *Bruno et al.* is improper as *Gow* provides a clear teaching away from use of a telephone calling card. For example, in col. 1, lines 23-46, *Gow* states that systems have been proposed in which a mail card is sold with a pre-allocated password in the form of a personal identification number (PIN) which allows the recipient to access a pre-recorded message via a telecommunications network. The reference additionally states that in systems of this type the revenue for the use of the service is generated by the sale of the card with the pre-allocated PIN. *Gow* then notes that there are several disadvantages inherent in this prior art system. First, the cost of production of a large number of otherwise identical cards, for example, is increased by the need to print a unique PIN on each item. Additionally, the PIN is preferably not visible until after purchase of the article to avoid unauthorized use of the system. A further difficulty is that each PIN allocated to an article at its date of manufacture must be stored in the system so that after sale the system can be accessed. This requires a rather large “stock” of unused PINs in the system since it may be many months before all articles are sold. The above drawbacks are characteristic of a telephone calling card, in that unique PINs are necessary and are not visible.

Moreover, a conclusion of obviousness is not compelled by the fact that the prior art could be modified so as to result in the combination defined by the claims; obviousness turns on whether the prior art suggests the desirability of the modification. See *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992); *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984); *In re Schulpfen*, 390 F.2d 1009, 157 USPQ 52 (CCPA 1968). Applicants submit that the modified system of *Gow* and *Bruno et al.* is strictly undesirable, as the modified system

would operate in a most undesirable manner. For example, the Office Action's proposed combination would require a calling card (assuming it can be construed as a "gift article") to contain a printed information block that specifies a number of the access control device and a password to access the voice greeting. As a result, the user must place two separate calls: a first call to listen to the personal greeting, and a second call to place an outbound call. Further, the caller may be charged for listening to the personal greeting (e.g., 1-900 billing number, or 1-800 credit card billing number). The undesirability of the combination is more evident, as the user may need to utilize the calling card to access the voice greeting, whereby the user is charged for the call (in the case of a 1-900 billing number) and for the voice greeting. Given the undesirability of the combined *Gow* and *Bruno et al.* system, the proposed combination can only be rationalized based on hindsight.

It is well settled that it is impermissible simply to engage in hindsight reconstruction of the claimed invention, using Applicants' structure as a template and selecting elements from the references to fill in the gaps. *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991). In this instance, the Office Action has attempted to modify the voice greeting system of *Gow*, which fails to disclose a telephone calling card, to accommodate the calling card system of *Bruno et al.* Recognizing, after the fact, that a modification of the prior art would provide an improvement or advantage, without suggestion thereof by the prior art, rather than dictating a conclusion of obviousness, is an indication of improper application of hindsight considerations. Simplicity and hindsight are not proper criteria for resolving obviousness. *In re Warner*, 397 F.2d 1011, 154 USPQ 173 (CCPA 1967). Therefore, Applicants respectfully submit that independent claim 27 is in condition for allowance. Because claims 28-30 depend from independent claim 27, either directly or indirectly, they should also be allowable.

Turning now to the obviousness rejection of independent claim 31, in which *Bruno et al.* is applied as the primary reference, while *Gow* is cited as a secondary reference. Independent claim 31 is directed to a method of using a pre-paid telephone calling card and recites "retrieving a pre-recorded personal greeting associated with said pre-paid telephone calling card based on said card identifier...." As previously noted, the Office Action on page 13, item 7 states that *Bruno* "fails to disclose personal greeting associated with said pre-paid telephone calling card." As a result, the Office Action is required to contend that *Gow* teaches retrieving a pre-recorded personal greeting associated with said pre-paid telephone calling card (page 13, item 7 of the Office Action). The Office Action concludes that it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a personal greeting associated with the pre-paid telephone calling card of *Gow* in the invention of *Bruno et al.* As argued previously, *Gow* fails to disclose use of a pre-paid telephone calling card.

Based on the previous discussions, it is undoubtedly clear that *Gow* provides no teaching of a pre-paid telephone calling card, and *Bruno et al.* lacks disclosure of a pre-recorded personal greeting associated with said pre-paid telephone calling card. The combination of *Bruno et al.* thus constitutes improper application of hindsight considerations, as reasoned above with respect to the combination of *Gow* and *Bruno et al.*

Further, Applicants suggest that proposed combination of *Bruno et al.* and *Gow* is improper, in that *Gow* is non-analogous art in contravention of MPEP §2141.01(a). Notably, one skilled in the art would not consult *Gow* to address the problems identified by *Bruno et al.*, as *Gow* is completely silent on telephone calling cards. *Bruno et al.*, in col. 1, lines 12-29, notes the problems with conventional calling cards, in that these cards provide the same service to each cardholder of a particular card, that is, each cardholder of a particular calling card receives the same type of service that other cardholders of the same card receive. If a particular calling card

is for long distance service, all cardholders of that card receive only long distance toll service. If a cardholder makes a long distance call originating from a cellular phone, only the long distance charges will be charged to the calling card account. Any charges associated with air time for the cellular service is billed to the subscriber of the equipment from which the call originates. The reference of *Bruno et al.* further notes that "what is needed is a way to record charges for services used by a calling card user, whether the calling card is periodically billed or prepaid, so that charges for actual services used by the cardholder accrue against the calling card account." This problem bears no relevance to the use of personal greetings as taught by *Gow*.

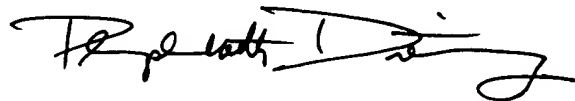
Accordingly, Applicants respectfully request that the rejection of claims 31-33 be withdrawn.

Therefore, the present application, as amended, overcomes the objections and rejections of record and is in condition for allowance. Favorable consideration is respectfully requested. If any unresolved issues remain, it is respectfully requested that the Examiner telephone the undersigned attorney at (703) 425-8508 so that such issues may be resolved as expeditiously as possible.

Respectfully Submitted,

DITTHAVONG & CARLSON, P.C.

6/26/02
Date



Phouphanomketh Ditthavong
Attorney/Agent for Applicant(s)
Reg. No. 44658

10507 Braddock Road
Suite A
Fairfax, VA 22032
Tel. (703) 425-8508
Fax. (703) 425-8518

